

## REMARKS

Claims 1, 3-10 and 16-28 are in this application.

Claim 1 has been amended slightly as indicated.

The examiner has rejected all claims under 35 USC §103 over Aotake in view of Yasuda and Terashima. Applicants believe that the examiner has not made out a *prima facie* case of obviousness.

1. It appears that the examiner has applied the 35 USC §103 rejection only to Claim 1.

Claim 1 requires:

“returning to the browser mode to enable the user to resume browsing the content of the CD-ROM disk,”

In Aotake, there is no “browsing the content” as required. In fact, the word “browse,” in any of its forms, is not found in Aotake. Neither is browsing taught. All that is taught is **selecting**. This can be seen at column 15, lines 46-56, where Fig. 20, that the examiner asserts teaches this claim limitation, is discussed. Those lines state:

“The item 3 is a menu picture for **selection** by the user using the menu. If the user moves a cursor, not shown, to a position 4 on the display screen using a mouse and clicks at the position, this is tantamount to indicating an area defined by selection region #4, thus indicating the **selection #4** offset of the selection table 1 corresponding to the region. The offset of the **list** of the corresponding number can be known from the contents of the section #4 offset, so that **selection** may be made of the **list** corresponding to 4 on the display screen.”

(Emphasis added)

So it is a **list** in memory that is being **selected**. The **content** of the disk is not being **browsed** as required by the claim. This can be further understood from column 15, lines 37-41. These lines state:

"Meanwhile, since the play item PI3 and the **selection** table 1 are substantially data belonging to the **selection list** SL1, the **selection list** SL1, the play items PI3 and the **selection** table 1 may be regarded as being one **selection list** SL."

That is, there is no "browsing the content" of the disk as required by the claim. There is merely **selection** of a predetermined **playlist**.

Therefore applicants assert that Aotake cannot properly be used as a base reference in a 35 USC §103 rejection of the claims because it does not disclose the claim limitations that the examiner asserts it discloses.

2. Even if "browsing the content" **were** taught in Aotake, that reference still cannot be used as a base reference in a 35 USC §103 rejection because there is no "reserving a portion of memory other than the CD-ROM disk for storing of a return address in the reserved portion of the memory" as now required by claim 1, *as amended*.

In his rejection, the examiner asserts that RAM 6 in Fig. 2 and column 23, lines 30-40, teach reserving a portion of memory other than the CD-ROM disk. The foregoing lines state:

"The playback signals for the optical disc from the signal processing circuit 2 **are routed** to a switching circuit 15 and to a CD-ROM decoder 3. If the optical disc is of the type of the CD-ROM, such as video CD of the present embodiment, the CD-ROM decoder 3 decodes the playback signals from the optical disc in accordance with the CD-ROM format. Of the signals decoded by the CD-ROM decoder 3, a variety of disc data, including the playback control information data **is routed** to the RAM 6, while the audio data and the video data are transmitted to a MPEG audio decoder 21 and to the MPEG video decoder 22, respectively."

There is no teaching of "**reserving** a portion of the memory other than the CD-ROM disk" as required by the claim. All that is stated in the quotation next above is that "playback control information **is routed** to the RAM 6...." This is not "**reserving** a portion of the memory." The location in RAM 6 at which the playback control information is ultimately stored is not shown to be a reserved location in Aotake. It could be chosen as the control information arrives. Aotake does not disclose reserved space. Even if the examiner takes the position that routing the control information to the RAM 6 **is** "reserving a portion of the memory," there is no teaching of

reserving a portion of the memory *for the purpose of "storing a return address in the reserved portion of the memory."*

Thus, for this additional reason, Aotake cannot properly be used as a base reference in a 35 USC §103 rejection of the claims because it does not disclose the claim limitations that the examiner asserts it discloses.

3. The distinctions discussed above in paragraph 1 and paragraph 2 with respect to claim 1, apply equally to claims 3-10 rejected by the examiner and, for this reason, applicants assert that claims 3-10 are allowable.

4. Even if the examiner were to take the position that Aotake can properly be used as the base reference in a 35 USC §103 rejection, the combination of references is incorrect, both as to Terashima and as to Yasuda, as discussed in paragraphs 5 and 6, below. The reason that the combination of references is incorrect is because MPEP § 2143.01 provides:

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)." (Emphasis added)

Further,

"Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 1732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)." (Emphasis added)

5. The examiner asserted that "Terashima teaches in col. 6, lines 13-20, providing a TOC buffer, for storing the start and end addresses of each piece of information recorded, as additional information, used in reproduction."

However, there is no suggestion in either Aotake or Terashima for combining Terashima with Aotake as required by the above MPEP section. As pointed out in paragraph 2, above, there is not even a portion of the memory (RAM 6) **reserved** in Aotake, in which to store the start and end address as required by the claims. Therefore combining the Table of Contents information

of Terashima is not suggested inasmuch as there is not even **reserved memory space** in which to place the Table of Contents information of Terashima. The examiner is using the teaching of applicants' invention, and not a prior art suggestion, as required in the quotations in paragraph 4, above, to make the combination.

6. The examiner also asserted that:

"Yasuda teaches in col. 6 and abstract, etc..., allowing the user to stop and resume reproduction using record position memory, using the record position being some sort of address information, reproduction is resumed, as taught by Yasuda."

Again, there is no suggestion in either Aotake or Yasuda for combining Yasuda with Aotake as required by the above MPEP section. There is no portion of the memory (RAM 6) **reserved** in Aotake, and therefore no place reserved to store the stop and resume information, much less a suggestion for combining the Yasuda information in the RAM 6 of Aotake. Therefore, combining the stopping and resuming information of Yasuda is not suggested inasmuch as there is **no reserved memory space** in which to place the stopping and resuming information of Yasuda. The examiner is using the teaching of applicants' invention, and not a prior art suggestion, to make the combination.

7. The examiner stated that "Claims 16-28 recite substantially similar limitations and are analyzed and discussed with respect to the claims addressed above, and further the recited claims read on the combination as applied."

Applicants assert that claims 16 through 28 are allowable for the same reasons as claims 1 and 3-10 are allowable.

In addition, claims 20 through 28 are article of manufacture claims. Therefore, these claims are also allowable because no **article of manufacture with processor readable code for programming one or more processors to perform the recited process** has been cited by the examiner.

8. Claim 6 is broader than claim 1 which the examiner rejected under 35 USC §103. If the examiner believes Aotake anticipates this broader claim 6, as opposed to an obviousness rejection based on a combination of references, applicants request that examiner please make

such an anticipation rejection of this broader claim 6. However, applicants again assert that, as was the case with claim 1, there is no teaching to resume "browsing the content" in Aotake, as required in claim 6.

9. For the above reasons, applicants request that the above rejection be withdrawn and a Notice of Allowance be issued.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 07-1896. The examiner is invited to contact applicants' attorney at (916) 930-3239 if there are any questions or if the examiner feels that a telephone conference will speed the prosecution of this application.

Respectfully submitted,

DLA Piper Rudnick Gray Cary US LLP

Dated: February 4, 2005

By



Peter R. Leal  
Attorney for Applicants  
Reg. No. 24,226

DLA Piper Rudnick Gray Cary US LLP  
Attn: Patent Department  
2000 University Avenue  
East Palo Alto, CA 94303  
Telephone: (916) 930-3239  
Facsimile: (916) 930-3201